REMARKS

This is a full and timely response to the outstanding final Office Action mailed January 26, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 9, 10, 21, 22, and 24-27 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that those claims are indefinite for describing analyzing images "during an image storing process". The Examiner then states that the phrase "will simply be ignored, and the claims will be examined with respect to the rest of the claimed invention." Applicant respectfully traverses.

As an initial matter, Applicant objects to the treatment of the limitation at issue. Irrespective of whether the Examiner believes that a given limitation is indefinite, the Examiner still has a duty to consider the limitation in determining whether the claims are allowable over the prior art. As is provided in the Manual for Patent Examining Procedure (MPEP) Section 2143.03 (emphasis added):

> *A claim limitation which is considered indefinite cannot be disregarded*. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds

only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

Given that the Examiner decided to disregard explicit limitations of Applicant's claims, the art-related rejections presented in the Office Action are *per se* improper. Because of this impropriety, the "final" status of the Office Action is likewise improper and should be withdrawn.

Turning to the merits of the rejection, Applicant respectfully asserts that the limitation at issue is both unambiguous and proper. That limitation specifies that the analysis that is conducted on the images in the method or by the system occurs "during an image storing process". Nothing about this limitation is unclear. This is particularly true when one considers Applicant's written description, which is to be used to interpret the claim limitations. The concept of performing such analysis during the image storing process is described in the written description in relation to Figures 4 and 5. Specifically, Applicant states:

> Referring now to FIG. 4, an example of operation of the image retrieval module 312 *during the image storing process* according to the present invention will be discussed. . . .
> Referring next to block 410, the image retrieval module 312 can *analyze the image to be stored for recognizable attributes*. Specifically, the image analysis algorithm 314 of the image retrieval module 312 can analyze the image in relation to stored attribute

associations. By way of example, the image analysis algorithm 314 can be preconfigured to recognize certain image attributes that pertain to sunlight, the sky, grass, trees, bodies of water, incandescent light, florescent light, human beings, human faces, animals, *etc.* Persons having ordinary skill in the art will understand that such recognition can be based upon color spectra, light spectra, object edges, object aspect ratios, position in the image, and so forth. With such stored attribute associations, the image retrieval module 312 can further add to the metadata associated with the image by noting attributes of the image (*e.g.*, by adding a metadata tag) that the user may not have identified with the keywords or phrases that he or she provided (if any). FIG. 5 schematically illustrates images and their associated metadata. As indicated in this figure, each stored image (image1, image2, . . .) can comprise metadata 500 including one or more keywords (keyword1, keyword2, . . .) and one or more identified attributes (attrib1, attrib2, . . .). (Applicant's specification, page 4, line 13 to page 5, line 14, emphasis added)

From the above excerpt, Applicant clearly describes the analysis that is performed on an image during an image storing process.

In view of the above, it is respectfully asserted that claims 9, 10, 21, 22, and 24-27 define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejections to these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhu, et al. ("Zhu," U.S. Pat. No. 6,345,274) in view of Kagami, et al. ("Kagami," U.S. Pat. No. 5,974,422). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art references do not teach or suggest all of the claim limitations, and there is no suggestion or motivation to make the modifications and combinations suggested in the Office Action.

As was described in the previous Response, Zhu appears to disclose a method and program for subjective *image content similarity-based retrieval*. As is described by Zhu, the Zhu system consists of three functional phases: (i) an image registration phase, (ii) a user preference understanding phase, and (iii) a preference-based image retrieval phase. Zhu, column 5, lines 8-10.

In the image registration phase, a set of feature extraction techniques is applied to an image to be stored to extract all of the relevant information, or metadata, needed for representing the image. Zhu, column 5, lines 12-17. The image and its associated representations are then stored in a database. Zhu, column 5, lines 58-61.

In the user preference understanding phase, user preferences are automatically extracted for desired images via user interactions. Zhu, column 6, lines 4-6. *In a query-based option, an image is first selected by the user as a query image. Next, images similar to the query image are retrieved using default preferences by using a representation-based similarity measure to identify and retrieve images that are similar to the query image.* Zhu, column 6, lines 8-18.

If the user preference understanding phase provides a candidate set of images that does not meet the user's preference for desired images, the process continues with the preference-based image retrieval phase, which was described in the previous Response. Turning to Applicant's claimed inventions, Applicant claims methods and systems that facilitate retrieval of stored images. For example, claim 1 recites a method as follows:

> 1. A method for facilitating image retrieval, comprising:
> querying a user as to at least one attribute of an image the user wishes to retrieve *by posing a series of explicit questions to the user*;
> receiving explicit user responses to the posed questions; and
> presenting at least one image to the user based upon the user responses.

The Office Action now acknowledges that Zhu does not disclose querying a user by posing a series of explicit questions to the user. However, the Office Action argues that Zhu poses a query to a user that comprises "implicit questions". In accordance with

the argument, the "querying" described in the Zhu reference is tantamount to posing such implicit questions to the user.

Although Applicant agrees that Zhu does not disclose posing explicit questions to a user, it is equally clear that Zhu further poses no "implicit questions" to a user. As is described above, the Zhu system *receives* a search query *input by the user*. Specifically, the user selects a "query image," which is received by the system and used to locate similar images for the user. Zhu, column 6, lines 8-18. Therefore, contrary to that alleged in the Office Action, it is the user that queries the system, not the system that queries the user. Moreover, the search query entered by the user does not comprise any "implicit questions," as is argued in the Office Action. Instead, the search query comprises an *image* that is selected by the user, and nothing more. Therefore, it is clear that Zhu neither queries a user, nor does so by posing "implicit questions" to the user.

Given the fact that Zhu does not pose "implicit questions" to a user, the combination of the teachings of Kagami and those of Zhu is unwarranted. Specifically, because Zhu poses no "implicit questions," there would be no motivation to a person having ordinary skill in the art to replace Zhu's supposed "implicit questions" with Kagami's explicit questions. Indeed, it appears clear that such a person would be motivated against such a combination given that the combination, and resultant modification of the Zhu system, suggested by the Office Action would contradict the very nature of the Zhu system.

Again, the Zhu system is a *image content similarity-based retrieval* system. We know this because that is the *title* of Zhu's patent. As such, a core concept of Zhu's system is that images can be retrieved based upon the similarity of the content of an image selected by the user (i.e., the search query). To simply replace this functionality with a system that poses explicit questions to the user would be to obviate the need for

Zhu's system. In view of this, the proposed combination and modification is not proper under 35 U.S.C. § 103.

Further, claim 1 recites *posing a series of explicit questions to the user.* Clearly, "explicit" is not the same as "implicit," and thus the rejection fails to meet the explicitly recited claim elements.

Given that the prior art does not provide the motivation for the combination and modification suggested in the Office Action, it appears clear that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components *selectively culled from the prior art to fit the parameters of the invention*).

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over Zhu and Kagami, and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

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